Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE BARETZ and MICHAEL A. TISCHLER

Appeal No. 2001-0554
Application No. 08/621,937

ON BRIEF

Before THOMAS, JERRY SMITH and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 6, 8, 10 through 18 and 20 through 29.

Representative claim 1 is reproduced below:

1. A light emitting device, comprising:

> at least one single-die semiconductor light-emitting diode (LED) coupleable with a power supply to emit a primary radiation which is the same for each single-die semiconductor LED present in the device, said primary radiation being a relatively shorter wavelength radiation outside the visible white light spectrum; and
>
> a down-converting luminophoric medium arranged in receiving relationship to said primary radiation, and which in exposure to said primary radiation responsively emits radiation at a multiplicity of wavelengths and in the visible white light spectrum, with said radiation of said multiplicity of wavelengths mixing to produce a white light output

The following references are relied on by the examiner:

Geusic et al. (Geusic)	3,593,055	Jul. 13, 1971
Tokailin et al. (Tokailin)	5,126,214	Jun. 30, 1992
Tadatsu et al. (Tadatsu)	JP 5,152,609	Jun. 18, 1993

Chao et al., "White Light Emitting Glasses" Jour. of Solid State Chemistry, Vol. 93, pgs. 17-29 (1991). (Chao)

Amano et al., "UV and blue electroluminescence from Al/GaN:Mg/GaN LED treated with low-energy electron beam irradiation(LEEBI)", Inst. Phys. Conf. Ser. No. 106, Chapter 10, pgs 725-730 (1989). (Amano)

Claims 1 through 6, 8, 10 through 18 and 20 through 29 stand rejected under 35 U.S.C. § 103. In a first stated rejection under 35 U.S.C. § 103 for these claims, the examiner relies upon Tadatsu in view of Tokailin, further in view of Chao. In a second stated rejection, the examiner adds to these three prior art references, appellant's admitted prior art, Amano and Geusic.

Rather that repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

We reverse.

The manner in which the examiner has asserted the obviousness of the claimed subject matter on appeal in the two stated rejections leads us to conclude that the examiner has failed to set forth a prima facie case of obviousness within 35 U.S.C. § 103. According to the statements of the two rejections at page 3 of the answer, the examiner has not met the burden on the examiner as set forth in MPEP 1208 which makes certain requirements for examiners setting forth rejections under 35 U.S.C. § 103. The examiner has not pointed out where each of the specific limitations recited in the rejected claims is found in each of the respective pieces of applied prior art in the rejections and identified the differences between the rejected claims and the prior art relied on. The rationale of combinability is conclusory. The statement of the rejection has not treated any dependent claim nor distinguished between the independent claims, 1, 18, 22, 23 and 25.

In this light, for example, appellants point out at page 4 of the Reply brief that claim 8 requires a semiconductor laser. Appellants assert there that each of Tadatsu, Tokailin and Chao do not teach a laser. The examiner has not asserted that the electric crystal display of independent claim 22 and its backlight member is taught or suggested in any of the applied art; the same may be said of the viewable panel of claim 23. The initial burden lies upon the examiner setting forth the rejection and not upon a panel of this Board to make the findings and specific correlations of the applied art to the claims when art rejections under 35 U.S.C. § 103 have been made.

Even if we were to agree that the examiner's rejections were meritorious or were proper within 35 U.S.C. § 103, we would have necessarily remanded the application to the examiner because the examiner has failed to properly address the assertions of secondary evidence set forth at pages 12 through 18 of the principal brief on appeal. Within these pages, the appellants have asserted a long felt but unsolved need with respect to certain portions of the specification as filed, the failure of others, and commercial success and scientific recognition, making specific references to Appendix B attached to the brief. As to all of this evidence and the arguments made by appellants in six

pages of the brief, the examiner offers for our consideration only one short paragraph at the bottom of page 5 of the answer which fails to address each and every assertion and argument made by appellants as to these different categories of secondary evidence. Moreover, in topic 5 at pages 6 and 7 of the Reply brief, appellants assert that the examiner has merely dismissed the substantial evidence of secondary considerations and avoids a proper consideration of it.

In view of the foregoing, we are constrained to reverse the stated rejections of the claims on appeal under 35 U.S.C. § 103 for failure to assert a prima facie case and to remand the application to the examiner. We note especially that the examiner is free to reinstitute the existing grounds of rejections to the extent the examiner chooses to comply with the requirements of MPEP 1208 regarding rejections under 35 U.S.C. § 103 and set forth a proper correlation of specific portions of the applied prior art to specific features of the claims on appeal. The examiner is also free to utilize new, different prior art not of record. In any event, should the examiner choose to reinstitute rejections under 35 U.S.C. § 103, the examiner is further required to address the evidence of secondary consideration set forth in the brief and reargued in the Reply brief.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d)(8th Ed., Aug. 2001).

REVERSED AND REMANDED

JAMES D. THOMAS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MICHAEL R. FLEMING Administrative Patent Judge	)	

JDT/vsh

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